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3-19.

IN THE
Supreme Court of the United States

OCTOBER TERM, 1918.

DOCKET No. 260.

GEORGE C. BEIDLER, APPELLANT,

vs.

THE UNITED STATES, APPELLEE.

BRIEF FOR APPELLANT.

(Appellant will herein be termed Claimant, and Appellee,
Defendant.)

STATEMENT OF CASE.

This is an appeal from the Court of Claims, by Claimant in a patent infringement suit in which the petition was filed February 14, 1914. The patent in suit issued to claimant, George C. Beidler, March 25, 1913, and is No. 1,057,397,

for improvements in Photographing and Developing Apparatus. The charge of infringement is based upon the use by the United States of certain photographic copying machines in various of its departments. The infringing machine is known and sold under the trade name of Photostat. The claims charged to be infringed are 17, 18, 33, 34 and 40. The Court of Claims found against Claimant on both infringement and validity of his patent, the finding or conclusion of non-infringement not being on the ground that the United States had not used the Photostat, the machine alleged to infringe (such use, in fact, being found in Finding IV), but seemingly because it was thought the claims in suit are not entitled to a scope that includes the Photostat, and the conclusion of invalidity being on the ground of inoperativeness of the "machines of said claims 17, 18, 33, 34 and 40."

Claimant, unsuccessfully, by motion for amended findings, T. R., p. 29, and by motion in the Supreme Court made October, 1919, sought to have certain errors in the Court's findings of fact corrected, and a desirably fuller finding of facts brought into the record on appeal. However, upon the record actually before the Supreme Court, no difficulty is apprehended of demonstrating the error of the Court of Claims in its conclusion of law on both validity and infringement.

THE ERROR OF COURT OF CLAIMS IN HOLDING PATENT INVALID.

The Court of Claims did not find that the patent claims in suit, or that the invention as defined in said claims, or any of them, is anticipated by the prior art referred to in the findings of fact; Defendant, indeed, did not ask for a conclusion of law that the patent is invalid for anticipation or want of novelty, for defendant's request for the conclusion of law ran:

"Defendant has not infringed the Beidler patent in suit; said Beidler patent in suit is invalid for vagueness and ambiguity of claims and for inoperativeness and insufficiency of disclosure."

The only bearing the Court of Claims considered the prior art to have on the case is in connection with the conclusion that Defendant has not infringed. Thus, in Finding VII, T. R., p. 27, immediately after a general analysis and listing of the patents of the prior art, the Court says:

"In the light of the prior art and the expert evidence in the case, it does not appear that any of the improvements patented to claimant have been used by the defendants," etc.,

Indeed, Finding VI, T. R., p. 26, expressly admits and points out that the prior art does not anticipate claimant's patented invention, such finding saying:

"In the structures disclosed by said patents, all of the above enumerated means were substantially the same as in the structure or machine of the claimant's patent in suit, *with the exception of the means for conveying the exposed section of film through the developing and other solutions or liquids.*"

And in said Finding VII, the Court of Claims uses the term "improvements" in referring to what Claimant had patented; that is, the Court admits and finds an advance or improvement by Claimant over the prior art. The sole question then on the infringement branch of the case, is the legal one of the construction and scope of the claims which the court found cover a new apparatus, and a new one which deserves and received from the Court, the creditable appellation of "improvements," and if their construction and scope are such as to embrace defendant's apparatus, which claimant charges infringes such claims. *Swiger v. Clamer, 192 U.S. 265*

The conclusion of law that the patent is invalid, obviously rests wholly on the erroneous finding of alleged inoperativeness of the machine of the claims in suit of claimant's patent, and the issue raised on that branch of the case is a mixed question of fact and law, the matters of fact being brought into this court by Findings VIII and IX, T. R., p. 27, and the patent itself, which is before this court as a part of the Transcript.

While the Court of Claims finds that what it terms "structural" changes from the illustration of the patent drawing, were necessary to be made, and were made to make an operative machine, and that a method of operation other than that disclosed in the patent must be and has been pursued to make the "structurally" changed machine work there is no finding of fact by the Court:

First, that the altered machine is not such a machine as the patent contemplates; and

Second, that one skilled in the art would not make the changes in relations of parts and pursue the mode of operation referred to and that such changes required an act of invention (Walker on Patents, 4th Ed., Sec. 175).

How, then, can a conclusion of law that the patent is invalid for inoperativeness of the mechanism disclosed in the drawings rest on the facts found?

The mere fact of change from the structure delineated in a patent drawing to make the machine work, does not, under the law, void the patent. It is only when the change is of a kind which would not be made by the skilled mechanic,—when it is of a kind calling for the exercise of invention, that the fact of such a change is fatal to the patent. (*Minerals, etc., vs. Hyde*, 242 U. S., 261; *Carnegie Steel vs. Cambria*, 185 U. S., 403.) On that essential and vital question, there is no finding of fact. And there are no facts on which such a deduction could be based, even if it were the

province of this court to draw deductions, which it is not (*Burr vs. Des Moines Railroad*, 1 Wall, 102).

The law on this point is well and clearly stated by the Court of Appeals for the 4th Circuit in the *Crown Cork & Seal Case*, 48 C. C. A. 72, as follows:

"The burden is upon the defendant in a case like this to prove want of utility. He must show either that it is theoretically impossible for such a device to operate or demonstrate by clear proof that a person skilled in the art to which the invention pertains has endeavored in good faith to make the patent work, and has been able to do so, and it follows that such evidence is overthrown or will be overthrown if it is demonstrated by practical experiments of credible persons that they have succeeded in producing by the patent process the results claimed by the patent." * * *

"The object of the drawings filed in the Patent Office is attained if they clearly exhibit the principles involved, and in a case like this rigid adherence to the dimensions thus exhibited is not required or expected, and if an intelligent mechanic would so proportion the dimensions as to secure practical results inutility is not demonstrated by experiments with material identical in form and proportion of parts with the drawings in the patent."

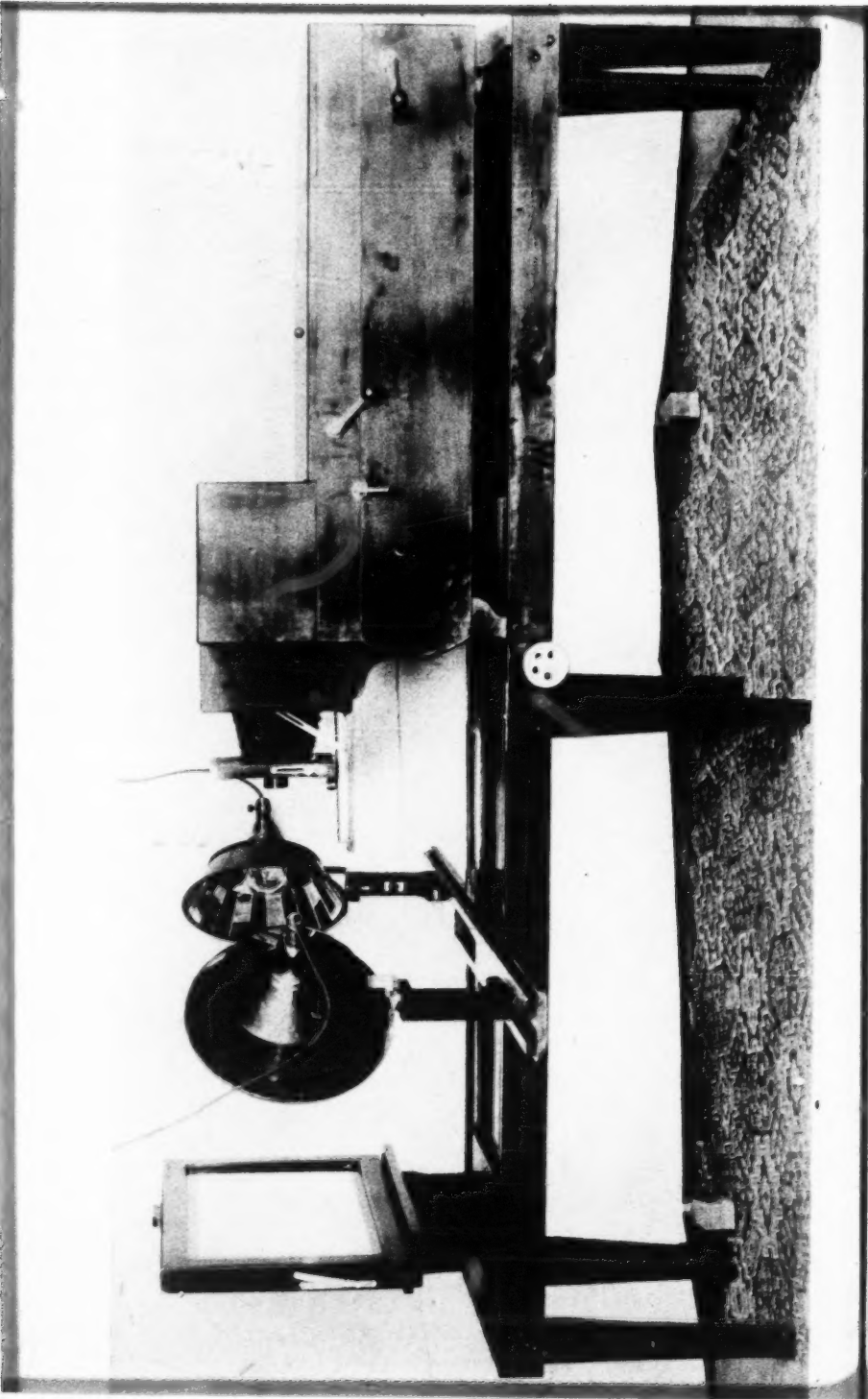
The finding in the first paragraph of Finding VIII that no machines of claims 17, 18, 33, 34 or 40 have been commercially manufactured and that it does not "appear" that any such machine has been constructed and practically operated, is without significance in the absence of a finding of explanatory facts. Mere non-use, in itself proves nothing (*Paper Bag Patent Case*, 210, U. S., 405), and mere absence of proof of construction and practical operation, is of no significance. If the Court had found as a fact that a machine or machines had actually been constructed and constructed by those skilled in the art, and operated by those

skilled in the art, and found to be impractical for defects that those skilled in the art could not cure, then the case would be on a different footing; but as it stands on the actual findings by the Court of Claims, it is not on that footing, but on the altogether different one that the *prima facie* presumption of utility or operativeness arising from the grant of the patent, stands in full and unimpaired vigor. (Crown, Cork & Seal Case, *supra*).

In fact, nowhere in the findings is there an assertion that a machine built in accordance with the patent drawings, and the specification, would be inoperative, even if literally and exactly followed, and much less is there any such finding that one skilled in the art, and without inventive acts, could not make such a machine with such departures from the drawing and description as his practical knowledge of the subject would reveal might be necessary.

It is rather curious that the Court of Claims limited such finding as it made with reference to operativeness, to machines of the claims in suit, and found nothing as to the machine as actually shown and described, and apparently that Court considered each of said claims as if it were the description of a separate machine, for in Finding IX, it advisedly used the plural form,—“machines” in its reference to the claims. Of course, unless the machine, as shown in the drawings, and as described in the specifications, is inoperative, and incurably inoperative in the hands of one skilled in the art, then an attack on its operativeness cannot succeed.

Understanding, as we do, the law to be that the burden is on one attacking the utility or operativeness of the machine shown in the drawings of a patent, and that that burden is to overcome the *prima facie* of the patent *beyond a reasonable doubt*, and that that burden requires it to be affirmatively established *as a fact* that one skilled in the art would



not be able from the teachings of the patent, to construct an operative, workable, useful machine, we submit that nowhere in the findings of fact of the Court of Claims, is there anything to justify, or support the conclusion of law that the patent is invalid for inoperativeness. Further discussion of this question of inoperativeness may therefore, be unnecessary, but the unreasonableness of the Court's finding of inoperativeness, is so clear when the law and the facts as found by the Court of Claims are considered, that we consider it our duty to go further into the matter.

At the outset, we emphasize the fact that the Court of Claims found that a machine "claimed by the plaintiff to be the machine of his patent in suit" was "An operative machine" and "shown to have been successfully operated in the production of intended results." (Finding VIII, T. R., p. 27.) With the Court's leave, we will produce that machine at the hearing, and take the liberty of placing opposite this page a reproduction of a photograph of it. That machine is literally described by each of the claims in suit of the patent, notwithstanding the variations said by the Court of Claims to have been made from the illustration of the patent drawing, for in not one of said claims is there any limitation to or anything said of the parts whose locations had to be slightly changed, or the form of the tray, whether lipped, or lipless, much less any limitation to the precise, or any particular location of these parts, or to the method of operating the machine. And all this is ascertainable by a simple comparison of the terms of the claims with what the Court of Claims in its findings says were the variations in these parts and the mode of operation of the machine, so that it is unimportant that said machine itself is not before this Court, as a piece of evidence, and that it be examined by the Court.

It is important to note that the Court of Claims, when it

says (first paragraph, Finding VIII), no machine has been constructed and practically operated "within the claims," *adds the qualification*,—"and by the disclosed method of operation of said patent." This is in effect a holding that the claims of a patent for a machine, are to be restricted to the mode of operation of the machine which the specification sets forth,—an obviously erroneous view of the law, when, as in the case at bar, the claims do not limit to that mode of operation, when they are not, and cannot be construed to be for a method or process, but are purely and wholly for a piece of mechanism.

Claimant, therefore, is in the commendable position, before this Court, of having concededly demonstrated the operativeness of a machine which is undeniably (and seemingly admitted by the Court of Claims) of a structure that is defined by each of the claims in suit, and which actually contains all the parts that are shown in the drawings of this patent, and the most and worst that can be said in criticism of the structure is that the locations of the clamp-operating pin U and the developer tray have been changed from the drawing disclosure and that instead of an outwardly projecting lip on the tray, it has an inwardly projecting lip,—the purpose of which is the obvious one of merely to prevent splashing out of liquid and is not said by the Court of Claims to have any effect on the functions performed by the other members of the machine. And the supposedly different location of the pin U is said to be merely to prevent repeated operation of the feed pawl and excessive feeding of film, but with no finding that "excessive" feed of film has any significance whatever and certainly none that it renders the machine inoperative. It might be wasteful of film, but the law will not damn a machine as useless, and strike down the patent for it merely because if built in a crude and unworkmanlike way, it is

not so economical of material as when it is built in a workmanlike manner (Walker on Patents 4th Ed. Sec. 79). A satisfactory and altogether sufficient test whether these changes are beyond the patent is, whether, if the defendant had used that identical machine, it would be held no infringement.

Another thing highly favorable to Claimant on the question of utility and operativeness is the fact that the trained experts of the Patent Office had the application for the patent under constant consideration for six years and so carefully and thoroughly considered the application that the Court of Claims was moved to say there were "numerous and repeated objections and rejections by the Patent Office" and "multitudinous amendments of specification and claims by the applicant" in response thereto. Is it believable for a moment that in all this long-drawn out, diligent and painstaking work of the Patent Office expert, he overlooked the important question of the utility or operativeness of the machine which so often, so long, and so critically he examined? It is not almost absurd, to say that this Government official,—the Patent Examiner, who holds his position by reason of his technical education and training, and knowledge of patent law, granted the patent without being satisfied that it was for a useful or operative, as well as novel, or new mechanism? We do not say that the United States is estopped in this suit to raise the defense of inoperativeness, but we cannot forbear suggesting that it is unseemly for the United States to raise such a question after taking claimant's money for his application fees, and compelling him to spend six years of labor to secure his patent, and after its own servants,—the Patent Office Officials, holding their positions because of their ability to decide such questions, and being by law charged with the duty to decide them, have solemnly held by the grant of the pat-

ent to claimant, the usefulness and operativeness of the apparatus which for six long years they scrutinized so carefully.

Having shown that there is no support for the finding in fact that the machine of the patent is inoperative, we will now explain the invention of the patent in suit and show infringement of that patent.

THE INVENTION OF THE PATENT IN SUIT.

The photo-copying apparatus of the patent in suit is not the first and only one of its kind invented by Claimant. His first patent issued in 1906, as No. 830,741, T. R., p. 27, upon an application filed three years before the application was filed for the patent in suit. In fact, he is the patentee of a number of patents relating to photo-copying apparatus, and his patented machines have been made, sold and used, T. R., p. 27, Finding VIII. In fact, as shown by the records of the Patent Office, of which perhaps this Court may take judicial notice, no less than some twenty patents for such machines issued to him between 1906 and 1917. Claimant therefore, is an experienced and active inventor of photocopying machines, and conversant with the actual requirements of these machines, in practice, and hence, the *prima facie* presumption of utility and operativeness arising from the grant of the patent is greatly strengthened by the fact of the experienced and practical source from which the machine of the patent in suit came (*McCormick vs. Aultman*, 69 Fed. 378).

The invention of the Beidler patent in suit has to do with apparatus for photographically copying or reproducing such objects as writings, drawings, etc., as will be seen from the statement appearing in the paragraph of the specification, beginning with line 9, page 1:

"This invention relates to printing and developing ap-

paratus and refers more particularly to an apparatus designed primarily for reproducing writings, drawings, pictures, or the like, novel means being also provided to convey to sensitized film through a series of receptacles containing suitable developing and fixing fluids or through suitable baths according to the requirements."

The drawing of the patent contains but two figures, one of which, figure 1, shows the machine or apparatus in vertical longitudinal section and the other, figure 2 shows it in top plan, with the top of the casing omitted.

In this machine the writing or other object is photographed directly upon sensitized paper and the paper, after receiving the image of the object, is subjected to the action of fluids suitable for the development and fixing of the image, and, briefly described, the machine comprehends a camera, a source of supply of sensitized paper, consisting of a roll thereof, in a chamber or compartment, means for drawing the paper from the roll or feeding it so that it is first exposed to the action of the camera and then presented to the treating fluids, a cutting mechanism or device for severing the exposed portion of the paper and holders or containers for the treating fluids.

The various parts of the apparatus, shown in the drawing, are contained in an oblong casing A that is supported by legs near each end. At one end of the casing is a chamber or compartment B, which contain the roll W of sensitized paper, and above the compartment B is an exposure chamber F for the camera G, such chamber containing an inclined mirror H for inverting the image and directing it to the portion of the sensitized paper below it and which is above the compartment B, having passed from the latter and being guided by rollers *b* to position to receive the image. From the rollers *b* the sensitized paper passes to and between feed rollers D, situated at the exit or rear

side of the exposure chamber F, by the revolution of which rollers the feed of the paper from the roll W is accomplished. Just beyond the feed rollers D is a knife O, which at the proper time is operated to sever or cut off the just exposed portion of the sensitized paper. The specification explains that the paper passes from the feed rollers D into a compartment E and in such compartment E is provided a series or succession of pans or tanks, as shown three in number, designated, respectively, I, J, and J¹, which are the containers or holders of the fluids or liquids used in the development and fixing of the picture on the sensitized paper, and into which the cut-off section of the latter is successively placed.

The edge of the paper, presented just beyond the knife O, is caught by a clamping device, composed of two clips N, situated to engage the paper near or at the side edges thereof. Each clip or clamp N is mounted at one end of a horizontal bar M at the top of the pans or tanks I, J, and J¹, and which is longitudinally reciprocable in the compartment E so that by the movement thereof the paper clamped by the clips may be placed in and drawn or passed through the liquid in each of said tanks or pans, and when the last pan J¹ has been reached, the clips carried back to position for engaging a newly exposed portion of the sensitized paper for the repetition of the operation just described. The clips are opened in order that they may receive the edge of the paper and also to release the section of paper when the last tank or pan is reached and, of course, they are closed after the edge of the paper has entered them in order to grip or clamp the same for transportation. In the machine shown in the drawing of the patent in suit, the opening and closing operations of the clips are produced automatically at each limit of reciprocating movement of the clips with the bar M. For this purpose a lever N² is pivoted to the side

of each of the bars M, the two levers being connected by a cross rod N¹ so that when one of them is engaged in the reciprocation of the bars M by a pin *m* at the point when the paper is to be released, or by a pin *n* at the point when the paper is to be clamped, both clips will be similarly operated. The pin *m* is designated in Fig. 2 of the drawing and the pin *n* in Fig. 1. As shown in the drawing, the paper is engaged by the clamps just after it has passed beyond the cutting device O. For reciprocating the bars M, they are provided with cog teeth which are engaged by gear wheels L upon a shaft K, which at one end has a crank for revolving it so that when said shaft is revolved in one direction, the clamp carrying bars will be moved longitudinally in one direction and when the shaft is revolved in the opposite direction, the clamp carrying bars will be moved longitudinally in the other direction.

The specification of the patent in suit explains that after the paper has been cut by the knife O, it is desirable to move the next succeeding portion of the paper a short distance beyond the knife to place it in the path of travel or reach of the clips or clamps and for this purpose the machine, which illustrates one embodiment of the invention of the Beidler patent, is provided with means for automatically acting upon the upper feed roller D to revolve it to cause the desired feeding movement. Such means consists of a ratchet wheel T on the upper feed roller D, a pawl S which at one end engages such a ratchet wheel, a lever R, to which the other end of the pawl is connected, and a pin or stud U on the upper side of one of the rack bars M, which, by the longitudinal movement of the rack bar is brought into contact with and rocks the lever R, to move the pawl S.

The function of the reciprocating paper clamp is twofold. First, it causes the subsection of the freshly ex-

posed sensitized paper to the action of the developing fluid, and second it is a transporting or carrying device by which the paper after being submerged in the developing liquid is taken therefrom and delivered to the liquid in the next following pan, or tray. Although the parts forming the organization are numerous and include all the elements for the performance of the photographic process of making the image by the camera, the development of the latent image thus produced and its fixing so that the single machine delivers, what, in reality, is a photographic copy ready for use, yet nothing is required of the operator for the achievement of this remarkable result beyond the pressing of the usual bulb to uncover the camera lens and again to cover it after the period of exposure and the manipulation of a few cranks, or handles—work that calls for no special ability, or skill whatever, but capable of being quickly learned and efficiently performed by any one.

This organization of elements is an excellent case of a true combination of elements notwithstanding that it includes a camera, that *per se* may exist as a separate entity, and parts of developing apparatus, such as the trays or pans that in themselves may exist and be used apart from the camera. In the Court below, defendant's counsel argued, but without convincing the Court, that there is no combination between the camera and the developing apparatus, which was but a reiteration of the objection made by the Examiner to certain claims of the application for the Beidler patent when pending in the Patent Office. See T. R., pp. 18 and 19. The answer to that contention of defendant is that the claims in suit do not cover merely a camera and a developing apparatus, but them and intervening elements including the feed rolls D and the knife, which tie the camera and the developing apparatus elements functionally together, and make the organized entity

of a true combination. The Patent Office Examiner saw to it that the claims of the patent in suit were worded so as to cover not the mere elements of camera and developing apparatus, but include the intervening or intermediary elements, which make the true combination.

Concerning the operation of the machine of the Beidler patent and the supposed disclosures of the patent itself in that behalf, the Court of Claims, Finding VIII, T. R., page 27, says:—

“By the method contemplated and disclosed in the patent, the film, with the exposed side up, held at one end by the clamps attached to the rack M and moving in a plane above the pans containing the developing and fixing fluids, is intended, by the outward movement of the rack, to be drawn successively through the developing and fixing fluids, the rack moving in one direction only throughout its entire course, the end of the film next the knife and away from the clamps falling, when severed by the knife, on the surface of the developer in the first pan and submerging by gravity.”

And in Finding IX, it is said that this mode of operation is inoperative because it will not submerge all portions of the film “with sufficient rapidity and uniformity to secure proper development of the film,” and the court then goes on to describe a mode of operation that is successful, terming that mode of operation, “the new oscillating mode of operation, evolved by the claimant,” but failing to find that such successful mode of operation is one that one skilled in the art would not resort to, or which called for the exercise of inventive skill for its discovery. Since the prima facie of operativeness of the machine of the patent has not been overcome and cannot be overcome by any finding of fact by the Court of Claims, as we have

already shown, it is not incumbent upon us to go beyond that unovercome *prima facie* and show that the expressions of the patent support the so-called "oscillating mode," which the Court of Claims found as a fact is successful. We, however, think that this can be done.

The so-called "oscillating mode" in reality involves nothing more than the reciprocation of the rack or racks M which support and carry the paper or film clamp. For some reason, not quite clear, the Court of Claims preferred the expression "oscillate" rather than "reciprocate" in referring to this movement of the rack. Both expressions, of course, mean merely a to and fro motion. The term used in the Beidler patent is "reciprocate." In describing the successful operation (See Finding VIII) the Court said, "The rack by means of the crank is oscillated back and forth in a range of a few inches until by its repeated reverse action operating against the resistance of the submerged or free end of the film, the film is finally rolled over, with its exposed side down in the developer and submerged." The "rack" referred to is the rack M of the Beidler patent and the "crank" referred to is the crank on the shaft K of the Beidler patent. This very described oscillation or reciprocation or back and forth movement of the rack by means of the crank on the shaft K is distinctly pointed to by the specification of the Beidler patent when it says T. R., page 5, "the said rack (M) being suitably guided in the compartment F and being alternately reciprocated through the rotation of the shaft in opposite directions." The specification does not say that these reciprocations are "in a range of a few inches," but it does say that the rack has a construction and arrangement by which the oscillating or reciprocating motion that was successful in submerging the print can be performed. And not only does the specification say this but numer-

ous claims of the patent which are just as much a part of the patent and the disclosure to the public of the invention and the mode of operation, thereof, as the specification, expressly states that the reciprocating or oscillating motion of the film carrier is to subject the film to the action of the developer liquid which the various tyro in the art in 1907, which was the date of the application for the Beidler patent, knew was necessary to the proper development of the latent image on the film. Thus claim 12 calls for a "to and fro moving member" for moving film holder and liquid in relation to one another, whereby the film is moved "through" the liquid in the receptacle. The expression "through" unmistakably points to submergence. Claims 17 and 18 specify a "reciprocating" film moving means or clamp to "subject the film to the action of the liquid holder." How else could the film be subjected to the action of the developer liquid except by being submerged? Again claim 40 specifies a "reciprocating development means operative to develop said exposed film." Language could hardly more plainly say that the reciprocating, or oscillating, or to and fro, movement of the film clamp or carrier is the thing that effects the development of the film, which development it was known by everybody required submergence of the film in the developer liquid.

We submit, therefore, no warrant for the view can be found that the so-called "oscillating mode" of operation found by the Court of Claims to be a wholly successful one and which involves nothing more than the capacity clearly explained by the specification of the Beidler patent of the rack or racks M to reciprocate or oscillate through a range of a few inches, is not such a mode of operation as is "contemplated and disclosed in the patent," but on the contrary is not only wholly consistent with the expres-

sions of specification and claims but is clearly disclosed thereby, and if that mode of operation is to be accepted as the test of operativeness of the machine, then the patent fully responds to that test for it is disclosed thereby.

There can be no question that had Beidler considered it necessary to amend his specification to make it describe what the Court of Claims said is the new method by which successful operation of the machine was secured, *and using the very language that Court used to describe it*, the Patent Office would have permitted, and the Courts have approved it.

The right of an applicant for a patent to amend is so large that it has been held to extend even to the repudiation of a theory of operation set up in the original specification and to complete rewriting of the specification and claims.

In *Western Electric Co. vs. Sperry Electric Co.*, et al., 58 Fed., 186-196, 7 C. C. A., 164, 173, Judge Woods speaking for the Court of Appeals for the Seventh Circuit, and with reference to an amendment to the application, said:

"At first Scribner, it is clear, believed the up-and-down compensating movement of the armature in the main circuit, irrespective of the action of the regulating magnet, to be an important feature of his lamp; but before the patent issued, without changing the drawing or modifying the structure of his device in the least, he presented an amended specification, in which he repudiated that idea, and described the armature in operation as assuming and holding a definite relation to the magnet. So long as he did not change the structure of his device or invention, he had the right to change the specification."

See also Court of Appeals for the 6th Circuit in *Cleveland Foundry Co. vs. Detroit Co.*, 131 Fed., 853.

INFRINGEMENT.

The Court of Claims, on the question of infringement, has made no structural and functional comparison of Defendant's apparatus and that of the claims of the patent in suit, and thereby made it appear that there are such differences between them as to support and justify the conclusion of law that there is no infringement. All we have, as to findings of fact on this point, is the explanation of the construction and operation of Defendant's machine, in Finding IV, and the reproduction, in Finding 1, of Claimant's patent specification, claims and drawings. What bearing the Court thought the prior art had on the question of infringement is not pointed out by the Court. The Court does not say Defendant's apparatus is like anything in the prior art. We are, therefore, concerned in this discussion only with the question whether Defendant's apparatus, as described in Finding IV is within the terms, or scope of Claims 17, 18, 33, 34 and 40, or any of them. ✓

Defendant's machine possesses all the characteristics of structure, mode of operation and capacity for work possessed by the apparatus of claimant's patent. Referring in particular to the drawing opposite, p. 18 T. R., it will be seen, like the apparatus of the plaintiff's patent in suit (the same reference letters being employed as in the Beidler patent in suit to designate the corresponding parts), there are, a camera G; a compartment B that contains a roll W of sensitized, or photographic paper; feed rollers D for drawing the paper from the roll into exposing position; a knife O to which the rollers D deliver the advancing end of the exposed portion of the paper; a number, or series of liquid-holding trays, or pans I, J and J¹ (three in number, as in the drawing of the patent in suit and arranged horizontally in a row as in the drawing of the patent in suit), and a reciprocating, or to-and-fro moving paper clamp N

which receives the forward edge of the paper as it comes from the feed rolls just as in the apparatus of the Beidler patent in suit, which clamp N, has, as in the case of the reciprocating paper clamp of the Beidler patent, the two-fold function of causing the submerging of the freshly exposed latent-image-holding paper in the developer liquid in the first pan I, and its transportation to a succeeding pan; and, as in the apparatus of the Beidler patent in suit, the various operations required for the performance of the entire photographic process are mechanically performed by the manipulation of a few cranks, or handles. The identity in structure, mode of operation, and function, or purpose of the print manipulating member of the Photostat and the same member in the apparatus of the patent in suit, is clearly and convincingly shown by the specification of the Greene patent found between pages 21 and 26, T. R., by the use of terms that describe structure, mode of operation and function that also accurately describe the same characteristics of the like member in the Beidler patent. Thus, in the Greene specification, the term "jaws" is used to describe the film clamp, and what more apt term could be used to describe the clips N of Beidler's patent, which so clearly appear in Fig. 1 as true jaws, which bite upon the interposed film? The Greene specification, uses the very term, "reciprocatory" or "reciprocating" to describe the to-and-fro motion of these "jaws" that is used in the claims in suit, of the Beidler patent; it calls the member that includes these jaws a "carrier," and the Beidler specification and certain claims use the word "carry" in referring to the action of the same member; and it describes the mode of use and function of this "carrier" in words that aptly fit the Beidler patent carrier. Thus p. 23 T. R., "The print may also be held within the carrier and the latter moved back and forth after the print is entirely immersed," etc.

Defendants, in the Court of Claims endeavored to make it appear that the "carrier" of the Photostat is not a carrier, but such a contention can be but discrediting to any one making it in the face of what it does, and the use of that exact term to describe it by Greene who patented it. Of course in respect of some details, such as the relative position of the parts and the precise form of the instrumentalities for manipulating the parts, the Photostat differs from the apparatus shown in the drawing of the Beidler patent in suit, but such differences are to be expected in an infringing device, the usual resort of the infringer being to take the invention of the patent in suit and to endeavor to disguise, or conceal it by changes of parts in matters of relative position and form. The Beidler specification anticipated that, for it was careful to say "A preferred form of construction of my apparatus will be herein described," but it is to be understood that this particular form is shown only for the purpose of illustrating one embodiment of the invention." Infringement, does not depend upon perfect imitation of the apparatus delineated in the drawings of the patent in suit, but upon the question whether the claims of the patent in suit so set forth the invention which is illustrated by the structure appearing in the drawing of the patent as to embrace defendant's embodiment of it. When the claims in suit are considered, no difficulty whatever will be had in finding that the claimant's invention has been appropriated by and is present in the Photostat.

Indeed, it is not necessary that as a matter of words, or terms, the language of a claim fit a defendant's construction. We are not to "judge about similarities, or differences by the names of things, but are to look at the machines, or their several devices, or elements in the light of what they do and to find that one thing is substantially the same as another if it performs substantially the same function in

substantially the same way to obtain the same result." *Machine Co. vs. Murphy*, 97, U. S., 120. The unimportance of difference in shape or form of corresponding devices, or elements of two machines is thus pointed out by the Court:

"Nor is it safe to give much heed to the fact that the corresponding device in two machines organized to accomplish the same result is different in shape, or form, the one from the other, as it is necessary in every such investigation to look at the mode of operation, or the way the device works, as well as the result, or the means by which the result is obtained."

THE PHOTOSTAT AND THE CLAIMS OF THE BEIDLER PATENT IN SUIT.

The invention of the Beidler patent in suit resides in, or consists of an organization or combination of co-operating elements, which constitute a photographing apparatus for converting sensitized paper supplied in large quantity to the apparatus into finished pictures, or prints, insofar as the operations of exposing, developing and fixing are concerned, and such elements are:

1. A holder of a supply of film, or sensitized paper that protects it from injury from actinic rays of light.
2. One or more liquid holders, or pans for containing the liquid, or liquids for treating the freshly exposed photograph on the film, or paper.
3. Means, such as rollers for drawing the film, or paper from the large quantity (the roll) with which the machine is supplied.
4. Means for cutting the film, or paper into copy lengths, and
5. Reciprocating, or to-and-fro moving device adapted to engage, or clamp the photograph-bearing portion of the film, or paper for that manipulation which is necessary to effect the development of the

latent photographic image and to remove the developer-acted-upon portion of film, or paper from the developer liquid for subsequent and further treatment.

The claims in suit set forth in differing forms of words the elements entering into the organization or combination, but since the invention is the combination of the elements, and not the particular construction of such elements, such, for example, as the particular form of the reciprocating, or to-and-fro moving carrier, or its instrumentalities for seizing and releasing the film, or paper; or the means for operating the paper feed rollers; or the location of the roll or film, or paper with reference to the camera, with these details the claims in suit are not concerned, but they define the elements above noted, and in particular the reciprocating or to-and-fro moving carrier in the most general terms, the claim writer having in mind the fact that the invention in its broadest scope is the general combination of elements set forth, and not the specific form of any one of them.

The particular claims in suit set forth the Beidler invention in broader and more comprehensive terms than the claims which were filed as a part of the application. It is simply a case, however, of frequent occurrence, where during the progress of an application through the Patent Office the applicant, or his attorney, redraws the claims, or presents additional claims to the end that the real invention disclosed in the original application, when its relation to the prior art is developed by the Patent Office examination, is better and more adequately claimed. *Hobbs vs. Beach*, 180 U. S., 396. There can be no question of new matter raised in this case. The claims in suit are entirely consistent with the drawings and specification as originally filed in the Patent Office, and merely define the invention as it was set forth in the original claims in terms that are more inclusive, or comprehensive—they include no element, or fea-

ture of construction not present in the original drawings and specification.

The only significance which the file wrapper and contents of the Beidler patent has, is that which Judge Mayer in the Second Circuit pointed out in *Brunswick Refrigerating Co. vs. Wolff*, 221 Fed., 639:

"The history of these letters patent, as disclosed by the file wrappers of the original patent and the divisional patents, demonstrates that the subject-matter received careful attention in the Patent Office. The inventor encountered the prior art, and the Patent Office was careful to the extent of requiring division, which was acquiesced in.

"Much is argued in regard to the proceedings in the Patent Office; but so far as these proceedings are material, they confirm the value of the presumption of validity which attaches to the issuance of letters. This is not one of the cases where, as sometimes happens, some important reference has been overlooked; but on the contrary this inventor had a long road to travel before he reached his goal."

As a matter of convenient reference in the specific application of the claims in suit to the Photostat, we quote such claims:

17. In a photographing apparatus, the combination of means for holding a supply of film, constructed to protect said film from actinic rays of light and having means for subjecting a portion of film at a time to the action of such rays, a liquid holder, film feeding means situated between said holder and the source of supply of film, and a reciprocating film moving means situated to receive the film coming from said film feeding means so as to carry said film and subject the film to the action of liquid in the liquid holder.

18. In photographing apparatus, the combination of means for holding a supply of film, constructed to pro-

tect said film from actinic rays of light and having means for subjecting a portion of film at a time to that action of such rays, a liquid holder, film feeding means situated between said holder and the source of supply of film, and a reciprocating film clamp situated to receive the film coming from said film feeding means and operative to subject the film to the liquid in the liquor holder.

33. In a photographing apparatus, the combination of means for holding a supply of film, constructed to protect said film from actinic rays of light, a liquid holder, film feeding means situated between said holder and the source of supply of film, and a reciprocating film moving means situated to receive the film coming from said film feeding means to carry said film and subject the film to the action of a liquid in the liquid holder.

34. In a photographing apparatus, the combination of means for holding a supply of film constructed to protect said film from actinic rays of light, a liquid holder, film feeding means situated between said holder and the source of supply of film, and a reciprocating film clamp situated to receive the film coming from said film feeding means.

40. In a photographing and developing apparatus, an inclosing casing adapted to contain a supply of film and having means for exposing portions of said film to actinic light, receptacles within the casing for containing developing fluids, a reciprocating developing means operative to develop said exposed film, means for delivering the film from the exposing means to reciprocating developing means, and means for severing the film.

Comparing Defendant's machine with the invention, as it is set forth in Claim 17, it will be found that, as, is required in Claim 17, Defendant's machine is, "a photographing apparatus," consisting of the combination of

(1) "means for holding a supply of film, constructed to protect said film from actinic rays," for the sensitive paper holding compartment and the exposure compartment of Defendants' machine fulfills this recital of Claim 17;

(2) "a liquid holder," the developer holder of Defendants' machine being this element of claim 17;

(3) "film feeding means situated between said holder and the source of supply of film," the feed rollers of Defendants' machine answering to this element of the claim; and

(4) "a reciprocating film moving means, situated to receive the film coming from said film feeding means, so as to carry said film and subject the film to the action of liquid in the liquid holder," this last element being present in Defendants' machine in the reciprocating paper clamping and carrying slide that moves to and fro in the developer containing pan or tray.

Although the film, or print clamping and reciprocating device does not, as in the particular machine shown in the drawing of the Beidler patent, carry the print through the successive pans or trays, yet that difference does not save Defendants' machine from being defined by and embraced within Claim 17, because that claim in its recital of the element of the reciprocating film moving means does not limit to or require anything more than the arrangement and operation of the film or paper clamping and moving means found in Defendants' machine.

Claim 18 of the Beidler patent in suit is similar in its recitals to Claim 17, differing therefrom only in the terms in which the last element of the claim is set forth, such last element being set forth as a "reciprocating film clamp situated to receive the film coming from said feeding means and operative to subject the film to the liquid in the liquid holder." The corresponding element in Claim 17 is set forth in broader terms as "reciprocating film moving

means." Inasmuch as Defendants' machine, has a film or paper clamp, it follows that Defendants' machine, notwithstanding this difference between these two Claims 17 and 18, responds to or is defined by Claim 18.

Claim 33 is similar in its recital to Claim 17, excepting that Claim 33 does not contain the language "and having means for subjecting a portion of film at a time to the action of such rays." It will, therefore, be seen that Claim 33 is broader than Claim 17, and, since in all other respects it is like Claim 17, it follows that Defendants' machine is such a structure as is defined by Claim 33.

Claim 34 is similar to Claim 33, excepting that, instead of the broad or general recital of "reciprocating film moving means" Claim 34 specifies a "reciprocating film clamp," and in Claim 34 the functional description of the film moving means appearing in Claim 33 is absent from Claim 34. The differences between the recitals of Claims 33 and 34 do not prevent the recitals of Claim 34 from setting forth or defining the construction of Defendants' machine, and, therefore Defendants' machine, is defined by Claim 34.

Comparing Defendants' machine with Claim 40 of the patent in suit, Defendants' machine is, as stated in the claim "a photographing and developing apparatus" in which there are

(1) an "inclosing casing, adapted to contain a supply of film and having means for exposing said film to actinic light," Defendants' machine having such a casing;

(2) "receptacles within the casing containing developing fluids," Defendants' machine having several liquid holding holding pans or trays;

(3) a "reciprocating developing means operative to develop said exposed film," such means being the sliding paper clamp;

(4) "means for delivering the film from the expos-

ing means in Defendants' machine being feed rollers D; and

(5) "means for severing the film," the last element being the knife in Defendants' machine situated just beyond the feed rollers."

It is noteworthy that Claim 40, while specifying more than one receptacle, nevertheless by its broad definition of the element of the reciprocating carrier which it specifies as a reciprocating developing means, operative to develop said exposed film, does not require that the reciprocating carrier shall traverse all of the receptacles, but its terms are satisfied by a structure such as that of defendants' where the reciprocating carrier after co-operating with one tank or tray by the submergence of a print therein and its removal therefrom, in whole or in part, delivers it to the succeeding receptacle, where its further handling or manipulation may be effected by means other than the reciprocating carrier. Whether the carrier in fact moves entirely over the second tank is inconsequential, as the thing of real moment is that it is the instrumentality by which, in addition to its co-operation with the first tank for developing, the print is delivered to the second tank.

The utility of that function of the reciprocating carrier of transferring the print from the developer tray, is pointed out in the Greene Patent, No. 1,001,019, as an "advantage" of the tray and slide construction of defendants' apparatus, in the paragraph beginning line 3, page 24, of the T. R., and it is that when "an operator makes the transfer by hand" his hands, wet with fixing solution, carry the latter into the developer pan. That the transfer function of the Beidler carrier is also performed by defendants' "reciprocating slide" as shown by the specification of the Greene patent, which says; last paragraph, page 23 T. R.:

"When it is desired to remove the print, the carrier may be raised by means of the handle until its front end is above the receptacle," etc.

THE PRIOR ART.

Doubtless the Court will find it unnecessary to examine the prior art patents (even if it should have power to do so, *De Bange Gas Check Case*, 224 U. S., 307), since there is no finding of invalidity because of the prior art. However, as defendants may try to bring the prior art before the Court, it may not be amiss to discuss it in this brief and show how utterly it fails of anticipation of the claims in suit.

Nowhere in the prior art is there to be found, as in the Beidler patent in suit, a photographic copying machine having a reciprocating device for seizing or clamping a sheet or section of film, subjecting it to the action of the developer, releasing it at the end of its movement in one direction, and then returning to repeat the operation on a subsequent sheet, or section, in combination with a photographic camera, a developer-liquid holder, and severing, or cutting means.

We will consider the prior art patents in their chronological order.

Ratzell patent of 1871.—The drawings are so unintelligible and the description so meager, that an understanding of the construction is impossible. This much, however, can be understood: The apparatus uses the ancient wet plates that are coated or sensitized when used; after sensitizing a plate is exposed for the picture. It is then removed from exposing position and placed under a faucet from which developer is discharged, the plate being meanwhile held to allow the developer to pour over it by a pair of pliers, by which it is removed from the place of exposure, and the, after being "fixed," is washed with water from a bottle.

which the user conveniently (?) carries in his pocket. The clumsy and slow operation involved in the use of this apparatus may not have been unobjectionable for taking a "picture of a corpse," to which time is no object, which the specification of the patent mentions as an illustration of its use (see paragraph next to claims, second column, p. 2), but it would hardly compete with a machine such as that of the Beidler patent in suit, which enables prints to be made faster than one a minute.

Parker patent of 1871.—The apparatus of this patent is constructed for the use of glass plates or "negatives," and means, comprising two devices termed "dippers," are provided for shifting the plates about in the camera for the performance of the operations of first sensitizing the plate; then placing it in position for receiving the image from the lens; next transferring it to and dipping it into the developing bath; and, finally, placing it in the water bath. The plate is transferred from one of the "dippers" to the other. These so-called dippers are each merely a sort of vertical rack on which the plate is placed so that it stands in a vertical position, and, of course, only a stiff, rigid object like a plate of glass can be used—the limp, flexible film of paper which the Beidler machine and that of defendant uses being impossible of such a treatment.

It must be evident that in this Parker patent there is entirely absent the combination of elements of the claims in suit of the Beidler patent, which comprises means for holding a supply of film, a knife or cutter for cutting from the web of film the portion thereof containing or to form a print, a reciprocating carrier having a film-engaging clamp and liquid holders in such co-operative relation with the carrier that the film that contains the image or the print may be submerged in the liquid in one of the holders and transported therefrom to another liquid holder.

Waterbury patent of 1872.—This patent is chiefly of interest in that it shows how, even as far back as 1872, it was the practice of the Patent Office to issue patents whose drawings and specifications did not pretend to go into details of construction. In this Waterbury patent there are certain feed rollers shown and referred to for feeding the paper, but nothing is said in the specification or shown in the drawings to indicate by what means the feed rollers may be made to exert that pressure on the paper which is necessary to feed it. The roll of paper and also the feed rollers are shown in the drawings as inclosed in a casing, but with no provision described in the specification for affording access to the interior of that casing for replenishing the paper by introducing a new roll or for threading paper between the feed rollers, and no provision is made for protecting from light the print or negative after it has been made by the camera and expelled therefrom.

Any detailed description of the construction and operation of the apparatus of this Waterbury patent is unnecessary, it being sufficient, in order to show that it is not the structure of the Beidler patent in suit as specified in the claims in suit, to call attention to the fact that the patent discloses no developing means whatever and hence no reciprocating film carrier and no cutting means, but concerns itself with the matter of making the photograph at no point beyond first sensitizing the paper, then feeding it into position for taking the picture, and then discharging it from the camera where it hangs pendant therefrom, as shown in figure 2 of the drawings, leaving the further operations of developing and fixing to be performed later, but with no information as to any mode of performing them beyond the general statement that the "finishing process will be like other photographic processes now (1872) well known."

Obviously this fragmentary apparatus of the Waterbury

patent which leaves the print in the incomplete state just pointed out is not an anticipation of the complete organization of the Beidler patent in suit, by the use of which, starting with the roll of sensitized paper, all the operations of making the image, cutting the picture-containing portion of the paper from the web, developing, and fixing—are performed.

Niel patent of 1874.—This patent is for a printing press. If the Beidler patent in suit sought to protect or monopolize as a sheet-carrying device *per se* the reciprocating carrier, then this Niel patent might be of some relevancy. On the facts of the case, however, its only value is to show that it was unnecessary for Mr. Beidler in his patent in suit to point out in any detail the paper clamping means of his reciprocating carrier, for such were old and well known in sheet-carrying mechanism, as shown, for example, by this very Niel patent. What Beidler's claims set forth is a combination or organization of elements but one of which is a reciprocating carrier of any desired construction, with any available paper-engaging clamps or clips. The consideration of this Niel patent therefore simply emphasizes the fact that the Beidler patent in suit is a combination of elements which includes some form of reciprocating paper carrier which will be able to perform the function of causing the subjection of the newly exposed film to the action of developer liquid.

Perry patent of 1890.—The device of this patent is termed a "photographic dipper," and it is nothing but a simple frame having a handle and provided with clips by which it may be made to hold a plate negative. The plate to be handled is taken by the hand and one edge slid under clips or lugs at one side of the frame, and the opposite edge of the plate or negative is engaged by buttons or clips on the opposite side of the frame. This dipper of the Perry pat-

ent is merely a convenient contrivance for holding the negative after it has been removed from the camera so as to avoid contact of the fingers or the hand of the operator.

Godfrey patent of 1892.—The machine of this patent has to do with pasting strips upon druggists' boxes and it shows a reciprocating sheet conveyor which has clips or clamps to engage the edge of the sheet. This Godfrey patent has the same relevancy to the Beidler patent in suit that the Niel patent does; that is to say, it shows the commonness in the arts of that element of the Beidler invention which consists of a reciprocating carrier having clamps to engage the sheets of paper, but like the Niel patent it fails to show that element in any such or any kindred organization as the photographic apparatus of the eBidler patent in suit and which defendant employs.

Pollak & Virag patent of 1901.—The apparatus of the Pollak & Virag patent was gotten up for enabling the performance of the operations that are performed by the apparatus of the Beidler patent in suit; that is to say, beginning with a roll of film, a portion of film at a time is made to receive an image transmitted by the lens of a camera, it is then cut off by a cutter and finally by means of endless bands or tapes moving continuously in one direction it is carried in succession into several liquid holders through which the tapes or bands travel for the purpose of developing and fixing the image. The apparatus of the Pollak & Virag patent is undoubtedly an impractical one. The means by which the film is supposed to be secured or attached to the endless bands or tapes are certain sharp-pointed pins placed at intervals along the tapes or bands which are obviously incapable of retaining the film in its passage through the liquid, for there is nothing to prevent the film dropping off from these pins, which it tends to do. Even if the pins merely entered the paper and formed holes snugly fitting

on the pins, this tendency would exist with the result stated, but the condition is aggravated by the fact that inevitably **the pins will tear or elongate the film holes** where they penetrate the film. But even were the Pollak & Virag patent machine operative, it could not be regarded as an anticipation of what is set forth in the claims in suit of the Beidler patent, because of the radical difference between the two machines in that whereas in the Pollak & Virag patent the film is intended to be transported by endless bands or tapes which move continuously in one direction, in the machine of the Beidler patent there is a reciprocating or to-and-fro-moving carrier. In one case there is an elaborate organization of numerous wheels and long bands or belts, which weave back and forth over the wheels, while in the other case there is the simple device of a reciprocating carrier, which difference means a saving of cost in original manufacture and a diminution of likelihood of getting out of order.

Dudley patent of 1903.—This patent shows merely a developing tray, which is in the form of a long, narrow pan with a top or cover, and in its use a roll of film is placed in the pan in one end and the portion of the film unwound from the roll is "engaged" in some way not clearly apparent from the disclosure of the patent by what is called a "drawrod" and the film drawn from the roll lengthwise of the pan, during which operation there is no liquid in the pan. This operation having been performed, a developing solution is poured into the pan or tray and the latter is then rocked to agitate the solution and cause it to flow over the film; and then later the developing solution is poured out of the tray and a fixing solution poured in and then finally the fixing solution is poured out and the film is washed. The purpose of Dudley is to develop at the same time all of a series of images on a length of film and afterwards, by a

pair of shears, the several pictures or negatives are cut off, Dudley making no provision whatever of means as a part of his tray for cutting off the prints, and requiring none.

Beidler patent of 1906.—The machine of this patent is of the type of that of the Pollak & Virag patent, there being endless bands which move continuously in one direction, by which the sections of film or paper, after being cut from the web, are carried to and through the developing and fixing liquids. The machine of the Beidler patent in suit, therefore, is different from the machine of the Beidler 1906, patent in the particulars in which the machine of the patent differs from that of Pollak & Virag.

And every one of the claims in suit will be found to point out, or set forth, in one form of words or another, the characteristics of the Beidler invention which distinguish it from the prior art and, in particular, that combination of elements, absolutely unknown in the prior art, which includes the reciprocating film, or paper carrier, that performs the dual functions of causing the submergence of the newly-exposed print in the developer liquid and its transportation therefrom.

The judgment of the Court of Claims should be reversed.

Respectfully submitted,

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Attorney and of Counsel of Claimant-Appellant.

CHARLES J. WILLIAMSON,

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Washington, D. C., February, 1920.



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JAMES D. MAHER,
CLERK

IN THE
Supreme Court of the United States

OCTOBER TERM, 1918.

DOCKET No. 260.

GEORGE C. BEIDLER, *Appellant*,
vs.

THE UNITED STATES, *Appellee*.

Supplemental Brief for Appellant

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“Patents for inventions are now treated as a just reward to ingenious men and as highly beneficial to the public. * * * Patents then are clearly entitled to a liberal construction.”—Mr. Justice Story, *Blanchard v. Sprague*, 1 Robb's Pat. Cas., 734.

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SUPPLEMENTAL BRIEF FOR APPELLANT

OPERATIVENESS.

On what we believe is the only question to be considered by this Court on the defense of invalidity of the patent, to wit, operativeness, defendant's brief has not a word to say in reply to our contention that the mere fact of variation from the disclosures of the patent drawing in order to render operative the mechanism shown therein is not enough to render the patent invalid as for an inoperative thing; that invalidity for

inoperativeness can only rest on affirmative proof by defendant, as a fact, that one skilled in the art can not from the teachings of the patent construct an operative device. That silence, of course, is not due to oversight. It is a recognition of what is elementary in the law.

In defendant's brief the term "model" is used persistently and repeatedly in referring to claimant's machine mentioned in Finding VIII. This is justified by nothing in the record, and as it is misleading, we feel constrained to call attention to it. The Court of Claims nowhere uses the term "model" in referring to that machine, but calls it, as it was, a full sized, operative machine that did commercial work. Its photograph appears opposite page 7 of our main brief. Moreover, it is clear that when in Finding VIII the Court said no machines within the claims in suit had been made, it in no sense disparaged said operative machine as not a full-sized commercial machine, but undoubtedly meant merely that it was not the machine of the claims because of the changes in construction which it considered had been made from the patent drawings.

Another departure from the findings by the Court of Claims is the assertion on p. 11 of defendant's brief, that the Court of Claims found that said operative machine operated on a different "principle" from "the patented apparatus." The Court did not use the word principle at all, but its finding was that the machine was operated after a different "method" from that disclosed in the patent; that is, the manner of using the machine was different. A difference of *principle* would be fundamental. Two or more different modes of use might well involve the same principle.

When the Court of Claims says in Finding IX that the so-called oscillating method of operation was evolved by claimant, it brings the case within those decisions which hold that the construction placed by a patentee on his own patent is to be adopted and followed by the Court in ascertaining what it means. In *Safety Car etc. vs. Gould*, 229 Fed., 429, a case in which the patent was attacked for insufficient disclosure, just as in the case at bar, the Court said:

“The rule of law is that a patent, when attacked for invalidity, should be viewed in a liberal spirit, and should not only be sustained whenever possible, but the construction placed upon it by the patentee should be adopted whenever this can be done without excluding anything from it or adding anything to it, which is not fairly contained therein,” citing *Rubber Co. vs. Goodyear*, 9 Wall., 788, and *Klein vs. Russell*, 19 Wall., 433.

But concede, for argument's sake, that the specification of the Beidler patent fails, in so many words, to set forth the operation which the Court found was practiced successfully, nevertheless, under well-known decisions, the patentee is entitled to such undisclosed mode of operation. *The patent is for the machine structure, not the mode of using it.* It is not for a process or method, but for a machine made up of certain elements or members, and its identity remains no matter in what manner those members are put through their motions.

“The manner of using does not characterize a machine. This is done by its structure and capabilities.”

Sewing Machine Co. v. Frame, 24 Fed., 596-599.

The Court's finding, we respectfully submit, makes the manner of operating the machine an essential and indispensable thing, and a part of the patent, and the logic of that position would limit every patent for a machine to the particular use of it which might be mentioned in the specification, notwithstanding it could be used in a dozen different ways not described or mentioned in the specification. It is impossible that, in the case of a machine, the patentee can be denied the right to use or work it in any way in which its parts, especially those specified in the claims, having the relation and organization required by the claims, can be made to operate or function, even if the patentee himself was ignorant thereof at the date of his patent, and indeed it was a matter of subsequent discovery by him or by someone else. As well put by the Court of Appeals for the 6th Circuit in *Jackson Fence v. Peerless*, 228 Fed., 691, at 696:

"The patentee is entitled to the benefit of every function within the scope of his claims and actually possessed by his mechanism, even if he does not know of it at the time of patenting."

As the Court put it, the test is whether the mechanism within the scope of the claims *possesses the functions*. In the case at bar, since the claims in suit in nowise, either by express terms, or by construction, bring into the mechanism which they specify, the pin U, the lever R, and the position or form of the developer tray, and since the reciprocating member which they do specify, can, in combination with the other elements they specify, be made to function as the Court of Claims found it did function, there is no question that under the law Claimant cannot be de-

nied the benefit of that mode of operation of that machine which the Court found resulted in success, for beyond dispute, that mechanism is "within the scope of the claims" in suit.

Claimant, no more than Gorham in *McCormick v. Aultman*, 69 Fed., 375 (6 C. C. A.), was required by law, under penalty of losing his valuable invention, to describe in full the functions of the reciprocating rack in performing the so-called "oscillating" method, or any other successful method.

"It is not stated that the grain is compressed against the guides D but their form and direction make it a necessary result of the mechanism described. The same thing is true of the wisp by the wisp matching function of the segmental teeth.

"It is not material that Gorham did not describe in full the beneficial functions to be performed by the parts of his machine, if those functions are evident in the practical operation thereof, and are seen to contribute to the success of his device: *Eames v. Andrews*, 122 U. S., p. 40."

McCormick v. Aultman, *supra*.

That the discovery of a new mode of operating an old machine, even if a new and different result ensues, does not make the machine a different machine, see *Boston Elastic v. East Hampton*, 1 B. & A., 222.

"The inventor of a machine is entitled to the benefits of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not." *Roberts v. Ryer*, 91 U. S., 157.

Claimant in his original specification referred to his invention as a *developing* apparatus. He knew, as everyone in the art knew at the time of his application

for patent (for it was a matter of common knowledge) that to secure development it was necessary to submerge the film in the developer liquid; and he knew, as an experienced and practical inventor in this art, as did the Patent Office experts, that mere dragging of the film over the top of the liquid, trusting to gravity to cause the film to sink in the liquid would be ineffectual to cause the necessary submergence. Any child, indeed, would know that if you hold a sheet of paper by one edge and haul it over the surface of a liquid, while suspended by the held, and advancing edge, the paper will trail along over the surface of the liquid. And yet, no greater intelligence than this is imputed to Mr. Beidler, and for six long years he fought in the United States Patent Office to obtain a patent for a thing which a child would know was a piece of folly. It is not denied that Claimant clearly shows and fully describes the construction by which the racks M are mounted so as to reciprocate from end to end of the machine. It is not denied, and cannot be denied, that such racks, constructed precisely as shown in the drawings, can be reciprocated by short two and fro motions, and that so reciprocated, the film will be successfully submerged in the developer. It was no more necessary for Claimant in his specification to write out in words the instructions to operate the machine in that way than it was for Gorham to say that he compressed the grain against the guides D. and Claimant's specification was "legally sufficient" because it set forth the structure of the racks, explained how they are moved to and fro, and repeatedly in the specification and claims asserts that the proper functioning of the mechanism results in *developing* the print. Claimant told what he proposed to do, provided mechanism by

which to do it, and it is established by the Exhibit machine referred to by the Court of Claims in Finding VIII that such mechanism will do it.

We might well let the matter rest here, and let pass unnoticed, the efforts of defendant's brief to point out the changes that defendant conceives were necessary to make an operative machine, especially since for arguments sake we could cheerfully admit that such changes were necessary because defendant's efforts must be utterly unavailing for lack of the vital proof that one skilled in the art would not make such changes. However, since these very efforts of defendant reveal the weakness of this attack of inoperativeness, we cannot forbear trespassing upon the time of the Court to point it out.

It will be found that defendant's whole case on inoperativeness turns on the matter of the automatic paper feed that consists of the ratchet rod S, the lever R and the pin *u*. This is evident from the elaborate illustration on page 16 of defendant's brief and the extended exposition thereof on pp. 15 to 18 of such brief. Suppose the law, not in the broad and liberal spirit which happily it manifests towards inventors, but in the narrow spirit with which defendant's counsel deals with this matter, and which erroneously and unfortunately the Court of Claims dealt with it, should require that the patentee must not, even by so much as a hair's breadth deviate, from the crude and necessarily imperfect drawing which forms part of his patent? That could only help defendant if the matter in question should pertain to something which the patentee unmistakably made vital and indispensable to the practice of his invention. It certainly could have no significance in regard to something which was not vital, but sub-

ordinate and which could be dispensed with, and especially, if the patentee himself indicated was subordinate and inconsequential.

Obviously, if it can be shown that the patentee contemplated the omission of these parts, the ratchet rod S, the lever R, and pin *u* which have caused defendant's counsel so much trouble and on which they hang the main defense, then the whole basis for defendant's contention disappears, and no basis whatever remains for the argument against operativeness, simply by omitting those offending members from the machine—which without them, will be a complete and perfect machine,—and capable of the perfect operation which the Court of Claims found was practiced with the Exhibit machine. Defendant's whole case as to operativeness hangs on the assumption, *first*, that said parts must be used in the machine; and, *second*, that they must be used in the machine in Chinese copy of the patent drawing, even as to the precise length of the rod S, and the precise location of the pin *u* in the mistaken notion that the law in that behalf is as inflexible and inexorable as the laws of the Medes and Persians.

We know that the second proposition is arrant nonsense; but must that automatic feed consisting of rod S, lever R and pin *u* be used at all, and have we any warrant for saying the patentee contemplated its non-use? *It need not be used*, and we shall show that the patentee considered it an unimportant thing, and that *it could be dispensed with*. The feed rollers D, are rotatable by hand, and hence the automatic feed by the rod S, lever R, and pin *u* is needless. *First*, Mr. Beidler considered this automatic feed so incidental and unimportant, that in his original specification *he did not even mention it*, see T. R., pp. 14 and 15. In-

deed, he described the entire movement of the film as performed by the *hand* rotation of the feed rollers, including that short movement for projecting the advancing end of the film beyond the knife, which in his amended specification he says may be automatically done. Thus, T. R., p. 15, his original specification says:

"Any suitable means may be provided for drawing the film through the exposure chamber, but I have shown the roller D. provided with a crank handle so that as the said roller is turned, the film will be drawn through the chamber and projected under the knife where it can be engaged by the clips carried by the rack."

Second. Not one of the claims in suit refers to the automatic paper feed produced by the use of the rod S, lever R, and pin *u*. How more convincingly could it be shown than by this omission that Beidler contemplated the building of his machine without the rod S, lever R and pin *u*

To treat the rod S, lever R, and pin *u* as essential and indispensable elements, even if they could not be so arranged as to render the machine, as a whole, operative, would be an arbitrary act "for no other purpose than to render the patent worthless." *De-Bange Gas Check Case*, 224 U. S., 307.

The cuts Figs. 3 to 5 opposite page 16 of defendant's brief (which were not proven) fairly well illustrate the submergence of the film by the so-called oscillating method (which those cuts show to be a rectilinear reciprocation of the slide) and they also make it clear that the omission of the rod S, lever R and pin *u* would have no other effect than to stop the auto-

matic feed of the film, the results of which are supposed to be delineated in Figs. 3 to 6.

THE PRIOR ART.

Of the fifteen prior patents discussed in defendant's brief, eight were considered by the Patent Office during the six long years claimant's patent application was pending. (See pp. 16 to 18, T. R.) And the patents chiefly relied on by defendant, Pollak and Virag, and Beidler were among those carefully considered by the Patent Office before it adjudged claimant to have invented a new, useful, or operative and patentable machine, and entitled to the claims in suit which cover in the broadest terms the photo-copying machine which has as its striking and distinctly novel element, the reciprocating film carrier, or slide, in contradistinction to the one-direction moving endless band and pulleys of Pollak & Virag, and claimant's prior patents. That defendant's counsel virtually cast their whole defense as to the prior art on the Pollak & Virag and Beidler patents, is shown by their reproduction of the drawings of those patents and only those, at p. 29 of their brief, and the fundamental difference between claimant's reciprocating carrier type of machine and the one-way moving endless belt of said patents, is apparent at a glance when the drawings of those patents are placed alongside the drawings of the patent in suit. In those prior patents numerous rollers (at least eleven in Pollak & Virag, and at least fourteen in Beidler) and an endless carrier of great length interlaced back and forth over said rollers, are employed resulting in a costly, complex and bulky machine. In the patent before the Court, there is nothing

but a mere frame or slide, inexpensive to make, requiring but little labor to work, without complexity and making a compact machine.

“This is not one of those cases where, as sometimes happens, some important reference has been overlooked [by the Patent Office]; but on the contrary this inventor had a long road to travel before he reached his goal.”

Brunswick etc. v. Wolff, 221 F., 639.

When the Patent Office after six years consideration of the Pollak & Virag and prior Beidler patents was satisfied the present invention was patentably different therefrom, that conclusion can safely be accepted.

INFRINGEMENT.

Defendant's brief makes a curious effort to show that defendant's carrier (*a*) is not a part of the machine; (*b*) it does not reciprocate; (*c*) it is not a “developing slide in any sense.” (Brief, pp. 40 and 42.) But answering (*a*) the brief itself (p. 42) refers to the “slide remaining at all times in the developing tank”; it says that unless this member, which is no part of the machine, is used, the operator must dip his hand in the chemical, to the injury of both hand and chemical, or as defendant's brief puts it (p. 42), with “results unpleasant to operator and detrimental to the solution.” This slide, which counsel say is no part of the machine, was found indispensable by the makers who first put out machines without the slides. (Defendant's brief, p. 33.) And the Greene patent, No. 1001019, under which it is said defendant's apparatus is made, rather conclusively shows that this slide is an element in the

organization (indeed, the Court of Claims in so many words, found as a fact that it is "an element of the machine," T. R., p. 20), for it claims it in its fourteen claims as an element of the combination with the tray or pan, and in its structural relation to said pan which enables it to reciprocate therein and to participate in submerging the film in the developer, thus performing a function in that relation. For illustration we quote Claim 6 of this Greene patent (T. R., p. 24):

"6. In a photographic print handling device, the combination with a liquid containing receptacle of a tray-shaped member shorter than the receptacle arranged therein to move back and forth to receive a print in flat condition," etc.

Answering (b), Claim 6, just quoted, shows that the slide does reciprocate, for it is said to move "back and forth," and the very term "slide" used in defendant's brief in mechanics, means a reciprocating part, and unless this "slide" has a reciprocating motion, how can it be put back in the tray from the partially withdrawn position shown in the drawing on page 41 of defendant's brief? The brief (p. 36) repeating the description of the operation found in Finding IV, refers to the return of the slide into the developer tray from its partially withdrawn position.

Answering (c), we quote from the Greene patent as conclusive upon the question of the part the slide or carrier plays in developing (T. R., p. 23):

"The carrier is then drawn forward * * * and the print 18 * * * is also drawn forward and the rear end thereof drawn beneath the guiding fingers 11 and in this way submerged in the liquid bath. If this movement is not sufficient to draw the whole print beneath the guide, the clamp-

ing jaw 12 is released * * * and the whole carrier is then thrust rearwardly again to the position of Fig. 2. [This sounds like a description of a reciprocating movement of the carrier.] * * * The print may also be held within the carrier, and the latter moved back and forth after the print is entirely immersed and flattened out to a proper condition FOR THE PURPOSE OF FLOWING THE LIQUID OVER ITS SURFACES, AS IS DESIRABLE IN TREATMENTS OF THIS KIND."

That the reciprocating slide or carrier of defendant's apparatus is a member of an organization which is operatively held in a certain working relation with the remainder of the organization is shown by the statements of Mr. Greene in his patent No. 1,001,019. Thus the Greene specification reads (T. R., 22):

"A preferably tray-shaped carrier 2 is arranged within the pan and preferably so proportioned as to approximately make a close fit therewith transversely thereof, but the tray is shorter than the pan so that latitude is given it for a reciprocatory movement back and forth longitudinally of the container."

In defendants' apparatus (and that of the Beidler patent) the reciprocating carrier not only has a construction by which it is fitted to receive the paper coming from the camera, *but by the guide which is formed by the static member* (the tray in one case and the box in the other) it is constrained or kept in such co-operative relation with the camera that the two are so joined that the entire organization works in accordance with its operative law for the production from a roll of film of separate, developed prints, which law involves the

operations of making the image, removing the exposed portion of the film from the camera, delivering the same to the reciprocating carrier, and then, by means of the latter, the delivery of the developer acted on print as a separate and independent unit from the developer tray.

The importance of the completion of the submergence of the print throughout its length and the fact that the reciprocating carrier or slide of defendants' apparatus has the important function of means for carrying the film and subjecting it to the action of the developer is shown by what Mr. Greene says in his patent 1,001,019. Says Mr. Greene, T. R., p. 23, beginning at line 4, as the rear end of the print is left projecting upwardly "arrangements *must* be made for lowering and submerging this rear end." And he says further that "if one movement of the slide is not enough to draw the whole of the print beneath the guide," then it is repeatedly gripped and moved by the reciprocation of the slide. The importance of this matter of the completion of the submergence of the rear end of the print is further shown by the statement of Mr. Greene in his patent No. 1,001,020. Thus, he says: "With the operation of introducing the print thus far advanced the problem is to submerge and flatten out the rear end 12 thereof, which particularly, when fed to the developer apparatus by automatic or mechanical means, is left projecting upwardly or outwardly"; and he says that this projection "is considerable." Mr. Greene in this patent also makes it clear that the function of the reciprocating "carrier" or "tray-shaped carrier" as he terms it, is also that of the reciprocating carrier of the Beidler patent for the removal of the

film from a developer pan or tray, for he says, "the carrier is also utilized to remove the print after treatment, for which purpose it is drawn forward and raised." The "also" in the foregoing quotation refers to the other function of the carrier just previously described by him for drawing the hitherto unmerged portion of the film into the developer and repeatedly reciprocating it.

Numerous errors and misleading statements appear in the comparison in parallel columns of the machine of the patent and defendant's machine, pp. 36 to 38 of defendant's brief.

Thus, in paragraph 1, it is said the two machines differ in that one is "automatic and mechanical throughout" while the other is "hand-operated throughout." The fact is that both are hand-operated throughout and the only difference between the two machines is the point of application of the hand to the mechanical devices which are employed in both cases and which constitute the machine.

In paragraph 2 it is made to appear that the feed rolls D of defendant's machine do not advance the paper into the clips or the gripping device of the reciprocating slide. The feed rolls D of defendant's machine deliver the paper to the clips or the clamping member of the slide. The bracketed reference in paragraph 2 to the crank handle of the machine for operating the feed rolls, at once punctures the assertion that the feed rolls are hand operated, if by hand operated it is meant that no mechanical device transmits the movement of the hand to the rolls. The mechanical device of the crank handle corresponds to the mechanical device of the machine of the patent for rotating the feed rolls, also a crank handle. Since the claims in

suit are not tied up with the feature of the advance feed of the paper, but include the feed rolls broadly for the performance of the function which they perform in defendant's machine, there is no point in the distinction between the two machines in that regard. The feed rolls of the patent while they do not direct the print into the developer, do deliver it to the developer pan and hence the only difference between the two machines is the plane or level of the developer pan to which the print is delivered. In defendant's machine it is a lower level. This is not a difference of any substance and certainly not one that enters into the claims in suit.

In paragraph 3 of the comparison it is said defendant's cutter 0 has nothing to do with the print getting into the developer pan. Until the cutter 0 of defendant's machine is operated it will hardly be said that all of the print is in the developer pan (at least a third is out; see drawing opposite p. 36, defendant's brief), and hence it is evident that the cutter 0 of defendant's machine does have something to do with getting the print into the developer pan.

The comparison of paragraph 4 is apparently on the theory that automatic action means an action which is produced through intervening mechanism even if the hand of the operator be the source of power that is transmitted. Even on that theory there is no real distinction between the two machines because in both machines appliances intervene between the point of application of the hand and the paper-engaging device. In the machine of the patent it is the crank which operates through rack and pinion and in defendant's machine it is the handle of the developer slide whose movements produced by the hand are transmitted through mecha-

nism to the print-engaging or clip part of the slide. Since defendant's slide is opened by the action of a spring it is truly automatic in its opening operation.

In the comparison in paragraph 5 reference to the direct application of the operator's hand in the case of defendant's machine is misleading and the statement that the slide of defendant's is not for the purpose of conveying or transporting, but to obviate the staining of the operator's fingers and contaminating the solution is ridiculous. The use of this mechanical device for moving the print through the developer and for transporting it out of the developer pan, and its being a co-operating part of the organization, is not changed by the thing which lead to its use, namely, the desirability of avoiding stain of the fingers and contamination of the solution. It is not a question of the purpose for which the thing is used or the reason for its use, but the fact of its use.

It is impossible to see any real distinction made in the comparison of paragraph 6 even if the facts are as stated. But they are not. In both machines the handle for the manipulation of the slide for development is on the outside of the machine. It is not true as stated in paragraph 6 with reference to defendant's machine, that the manipulation of the print is by means of the hands in any sense in which the hands are not used in the operation of the machine of the patent.

The comparison in paragraph 7 is not correct particularly in the statement that in defendant's machine there is no mechanism for removing the print from the developer to the succeeding baths because in defendant's machine the slide is used in the operation of transferring the print from the developer to the next bath.

Of course defendant has not copied the machine illustrated in the drawings of claimant's patent *in all its details*. Defendants rarely do that. They take the substance and try to conceal it by superficial changes. Sometimes they do as defendant did here. They employ an inferior construction and sometimes even impair the functions of parts. Defendant's slide is clumsy or crude compared with the corresponding member of the patent in suit and defendant manipulates that slide so as not to secure the advantage of *complete* transportation of the print from one bath to another. The use of an imperfect form of a device is characterized by the Court of Appeals for the Second Circuit in *Van Kannel v. Straus*, 235 Fed., 135, as a "subterfuge which the courts will not pass."

"The impairment of the function of a part of a patented construction by omitting a portion will not avoid infringement."

Manton-Gaulin v. Dairy, 238 Fed., 210.

"We think O'Brien's construction comes within the settled rule that infringement is not avoided by impairment in degree, so long as the distinguishing function is retained."

Murray v. Detroit, 206 Fed., 465 (C. C. A. 6).

Defendant in its slide retains the "distinguishing function" of the invention of the patent in suit, for it is a reciprocating print clamping device that receives the print fed from the camera by the feed rolls and cut off by the knife; it passes the seized print through the developer and it carries the print from the developer to the next bath, imperfectly it is true, that is to say, it does not take the print completely over into the succeeding bath but it takes it partially over, but unless it

took it partially over the hands of the operator would be stained and the solution contaminated because it would be necessary to reach the hands into the developer, so that the most that can be said for defendant's slide in respect of this transporting function is that it but partially does the work of the slide of the patent in suit and thus amounts to the familiar subterfuge of an impairment of function in degree.

It is to be borne in mind that the expression "reciprocate," as used in the claims in suit, need have no other meaning to embrace defendant's machine than that contended for by defendant, namely, a motion first in one direction between the point where the carrier clamps the film and the point where the film is released, and then in the opposite direction to repeat the film engaging and transporting operation. The term "reciprocate" need not be understood to mean the short reciprocations by which submergence is effected in claimant's machine, although obviously it does include such short reciprocations, which according to the Greene patent are used in the normal operation of defendant's machine.

For convenient comparison of the drawings of claimant's patent and the drawings of defendant's machine, copies thereof are inserted at the back of this brief.

CRITICISM OF CLAIMS.

We do not consider it necessary to answer in detail the supertechnical, hypercritical discussion in defendant's brief of the claims. Reference to part will suffice. What possible importance can it be that some of the claims use the general designation "photographing apparatus" and others "photographing and developing apparatus?" The supposed difficulty in un-

derstanding Claims 17 and 18 would have disappeared if the destructive critic had not overlooked the preamble in each claim, "In a photographing apparatus" (which he omits from his supposed quotation, p. 48). What these claims call for is a "photographing apparatus" in which are found the various elements recited therein and all those elements are readily understood by reference to specifications and drawing.

This attack upon the claims is but another manifestation of the notion on defendant's part shown by the attack on the validity of the patent for inoperativeness or insufficiency of disclosure, that that construction of a patent is to be resorted to, if possible, which will destroy and not save it; that an inventor is to be treated as if taking something from the public instead of as a benefactor. The true attitude, the one in consonance with the purpose of the provision of the Constitution on the subject, was long ago pointed out by Judge Story in *Blanchard v. Sprague*, 1 Robb's Pat. Cases, 734, as follows:

"Patents for inventions are now treated as a just reward to ingenious men, and as highly beneficial to the public * * * as ultimately securing to the whole community great advantages.
• • •

"In America this liberal view of the subject has always been taken; and, indeed, it is a natural, if not a necessary result, from the very language and intent of the power given to Congress by the Constitution, on this subject, * * * Patents then are clearly entitled to a liberal construction since they are not granted as restrictions upon the rights of the community, but are granted to 'promote science and useful arts.'"

Not only has claimant's patent been attacked upon a perverted and mistaken view of the law, but it is asserted on page 19 of defendant's brief that he is using his patent and this suit with an ulterior motive; it is said he is trying to bludgeon or "club" the United States into dealing with him. On the record made in the Court of Claims, which, unfortunately, we could not bring to this Court, this attempt to place the United States in the position of the "injured innocent" would be found to invert the real situation. Had we been able to get that record here, it would have shown this claimant to be a pioneer in this art, and that it was at his expense and by his labors and the introduction of his machines that the primitive, slow, inaccurate and costly hand-method of copying documents was displaced. We beg leave to quote from page 7 of our petition for certiorari in this case to the Supreme Court the following:

"The record in this case shows that when machines of the same general type (patented by claimant) were first introduced into use (which was by an installation by claimant in the General Land Office of the Interior Department in 1909) such a method of copying records was wholly new in the government bureaus, and the method in use was the primitive, slow, costly and frequently faulty one of hand-copying, by pen or typewriter. The operation of that first machine installed by claimant aroused great interest in government circles and it was the subject of reports to the Secretary of the Interior, and the Efficiency and Economy Commission, appointed by President Taft, and to a sub-committee of the Appropriations Committee of Congress, and committees from the Patent Office and other government bureaus investigated that first installation in the Land Office."

The evidence in support of the foregoing is quoted on pages 10 to 16 of that petition.

Respectfully submitted,

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CHARLES J. WILLIAMSON,
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Washington, D. C., April 21, 1920.

ADDENDA.

Perhaps, too, this Court will permit us to quote from Senate Document 293, which contains a letter of President Taft dated Feb. 5, 1912, and the Report of the Commission on Economy and Efficiency, dated December 4, 1911, which show *first*, how revolutionary was the change in Government methods of copying, wrought by the introduction of the photo copying machine, such as that of claimants' patent and defendant's photostat, and *second*, how novel and unique in the practical art at that date was such a machine, and, therefore, proves by implication, the inadequacy of the art, as shown by the patents relied on by defendant to measure up to the practical needs. In that Report, the Photostat is mentioned as the machine under consideration, but praise of the Photostat, is eulogy of claimant's machine because, as we have shown, the two are brothers, in all essentials of structure, functions and results. This Report is dated some four and a half years after the filing of the application for the Beidler patent in suit, which was March, 1907, and as far back as September 22, 1909, claimant was making broad claims to his invention, Finding III, T. R., 16.

We quote as follows from Senate Document 293:

"Its investigation has led the commission to the opinion that this device . . . if used to the extent to which adapted, an annual economy of not less than \$100,000, and possibly of two or three times that sum, can be secured."

.

"Exhibit B * * * represents a tabulated statement originally prepared on the typewriter, * * * the cost of reproduction by the typewriter process would be about \$2.50, whereas the cost by the process shown was but 8 cents.

"The operation of the machine does not require the services of a high class clerk; in fact * * * even a messenger could be employed on this work with results equal to those produced by a clerk of the highest class.

"The photostat is almost automatic in operation," etc.

Not merely has the "Government testified to its excellence by using" the invention, as said in the *De Bange Gas Check Case, supra*, but by this Report has expressly testified thereto. And in that case as in this, the device of the Government followed another patent, and differed in its construction from that shown in the patent in suit, and the same contention was made that it was not within the restricted scope of the claims for which the Government contended.